

U.S. Application No. 10/613,299
Response to Office Action Dated
May 12, 2005

REMARKS/DISCUSSION OF ISSUES

Claims 1-16 and 18-19 are currently pending in the present application. Claims 1 and 9 are the independent claims.

Rejections Under 35 U.S.C. § 103(a)

1. Claims 1, 3, 9, 12-14 and 16-19 have been rejected under 35 U.S.C. § 103(a) as being unpatentable in view of *Lane, et al.* (U.S. Patent 5,148,230) in view of *Joline, et al.* (U.S. Patent 6,005,696).

2. Claims 2, 4, 10, 11 and 15 have been rejected under 35 U.S.C. § 103(a) as being unpatentable in view of *Lane, et al.* further in view of *Joline, et al.* and *Tanimoto, et al.* (U.S. Patent 6,069,697).

3. Claim 5 has been rejected under 35 U.S.C. § 103(a) as being unpatentable in view of *Lane, et al.* further in view of *Joline, et al.* and *Swanson, et al.* (U.S. Patent 6,580,531)

4. Claims 6-8 have been rejected under 35 U.S.C. § 103(a) as being unpatentable in view of *Lane, et al.*, and *Joline, et al.* further in view of *Swanson, et al.*

For at least the reasons that follow, it is respectfully submitted that the noted rejections are improper and that all rejected claims are patentable over the applied art.

An initial requirement of a proper rejection under 35 U.S.C. § 103(a) is that all of the claimed elements be found in the applied art. If a **single** claimed element is not found in the applied art, a *prima facie* case of obviousness cannot be properly established.

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Moreover, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is a teaching, **suggestion or motivation to do so found in the references themselves** or in the knowledge generally available to one of ordinary skill in the art. However, hindsight is never an appropriate motivation for combining references and/or the requisite knowledge available to one having ordinary skill in the art. To this end, relying upon hindsight knowledge of applicants' disclosure when the prior art does not teach nor suggest such knowledge results in the use of the invention as a template for its own reconstruction. This is wholly improper in the determination of patentability.

I. Claim 1 is drawn to an optical testing unit for measuring sensitivity of an optical device under test (DUT). The optical testing unit features, *inter alia*, **"...a graphical user interface, which provides an interface with a user...[and] a memory module, said memory module comprising a sensitivity module..."**

Claim 9, drawn to a method of optical testing includes similar features.

Illustratively Fig. 8 shows the GUI 160, which is described in detail in paragraphs [00064] through [00067] of the filed application. Notably, the GUI 160 provides a point of interaction or communication between a human operator and the optical testing unit. This interaction provides a mutual or reciprocal action or influence between the operator and the GUI 160. For example, the operator may initiate a calibration procedure by selecting discrete selection option 140; and the GUI may provide to the

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operator the results of the calibration.

Fig. 5 shows a sensitivity module 256 of the memory 254. Paragraphs [0049] and [0050] of the filed application describe the structure and function of the memory module 256. For example, the sensitivity module 256 adjust traffic type and rate, adjusts the overall quality of the optical signal and examines the traffic return from the DUT to verify that it can recover information from it. Moreover, the memory 254, its partitioning and the modules' being resident in software is also disclosed.

The Office Action notes that the reference to *Lane, et al.* does not disclose a GUI or a sensitivity module. The Office Action then attempts to cobble elements from the references in order to reconstruct Applicants' invention. To this end, Applicants first note that the structure and function of the sensitivity module are disclosed and that neither *Lane, et al.* nor *Joline, et al.* disclose such a sensitivity module. Thus Applicants respectfully submit that the references taken individually or in combination neither teach nor suggest at least one of the features of independent claims 1 and 9. For at least this reason, it is respectfully submitted that a proper *prima facie* case of obviousness has not been established and that claims 1 and 9 and the claims that depend therefrom are patentable over the applied art. Allowance is earnestly solicited.

Furthermore, it is respectfully submitted that the Office Action has improperly combined the teachings of the applied art to produce the claimed invention where there is no teaching, suggestion or motivation to do so found in the references themselves. The reference to *Lane, et al.* discloses a user interface 40' that may be used to generate beginning and end signals. However, there is no teaching,

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suggestion or motivation to provide a GUI as featured in claims 1 and 9 and as described in the filed application.

The Office Action asserts that the GUI described in *Joline, et al.* is properly combinable with the disclosure of *Lane, et al.* Applicants respectfully disagree.

Notably, *Joline, et al.* discloses a communications network with a plurality of office and a **test center**. The **test center** **engages the network** in order to test certain links in the network. The reference discloses the use of a LAN with a GUI interface on a monitor, personal computer or a workstation in the initiation of a test sequence. Thus, *Joline, et al.* does disclose a GUI and the GUI may be used in testing, but there is no teaching nor suggestion to provide the GUI of *Joline, et al.* in an optical testing unit. Stated differently, the reference merely includes a GUI at a PC or other terminal, with the GUI used in a test sequence. The GUI is not part of or is suggested to be part of an optical testing unit.

The modifying of the teachings of the prior art to produce the claimed invention to establish of a *prima facie* case of obviousness requires a **teaching, suggestion or motivation to do so** found in the reference itself. Because the onus to establish a *prima facie* case of obviousness lies on the Office, and because the Examiner has failed to disclose the requisite teaching suggestion or motivation from the reference to modify the reference applied, it is respectfully submitted that a proper *prima facie* case of obviousness has not been established.

II. The rejection of claims 2, 4, 5-8, 10, 11 and 15 is also improper. Notably, these claims depend directly or indirectly from either independent claim 1 or independent claim 9. For reasons set forth above it is respectfully

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submitted that these independent claims are patentable, thus all claims that depend from these claims are also patentable. Thus, while Applicant neither concedes the propriety of the rejections or the combination of the references, it is respectfully submitted that claims 2, 4, 5-8, 10, 11 and 15 are patentable.

Conclusion

In view of the foregoing, applicants respectfully request the withdrawal of the objections and rejections of record, the allowance of all pending claims, and the holding of the application in condition for allowance.

If any points remain in issue, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and further replies to charge payment or credit any overpayment to Deposit Account Number 50-0238 for any additional fees under 37 C.F.R. §1.16 or under 37 C.F.R. §1.17. Notably, permission is hereby given to charge the above Deposit Account for the fee required (small entity) for a one-month extension, extending the period of response to September 12, 2005.

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August 29, 2005

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